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1911 THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR(S) Tucholski et al.) EXAMINER: A. Skapars

SERIAL NO: 641 394 } ART UNIT: 1104

FILING DATE: January 15, 1991) DATE: September 22, 1993

FOR: BATTERY WITH TESTER)
LABEL)

PETITION FOR ACCESS TO APPLICATION FILE

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

Pursuant to 37 C.F.R. §1.14(e)(i), the undersigned petitioner hereby respectfully requests access to the files of U.S. patent application serial no. 07/641,394, which is believed to be currently pending in the U.S. Patent and Trademark Office. The petition fee of \$130 is enclosed.

A continuation-in-part of the above referenced application was issued on June 29, 1993 as U.S. Patent No. 5,223,003. The '003 patent discloses and claims a process for preparing a label comprising a tester for a battery and for attaching it to a battery. The parent application for which access is requested is believed to be directed to similar subject matter. A European patent application claiming priority of the referenced U.S. application was published as no. 0 495 636 on July 22, 1992, and a copy is enclosed herewith.

Access to the referenced pending application is requested for the purpose of determining the scope of coverage of the claims of the '003 patent and, therefore, access is requested to any and all prosecution in the subject parent application relating

to either a label having a tester for attachment to a battery, or a process for preparing a label having a tester for attaching to a battery.

The Court of Appeals for the Federal Circuit has stated that argument and amendment in a patent's prosecution history, including that made in parent applications, are relevant in determining the scope of the claims. *Jonsson v. The Stanley Works*, 903 F.2d 812, 14 USPQ2d 1863 (Fed. Cir. 1990). Furthermore, a competent and credible opinion of counsel must include a review of the file histories of the patent in issue. *Underwater Devices, Inc. v. Morrison-Knudsen Co., Inc.*, 717 F.2d 1380, 219 USPQ 569 (Fed. Cir. 1983). Since the file of the '003 patent merely contains a first office action allowance, petitioner needs to have access to the subject parent application in order to determine how words and terms may have been defined, and to determine what claim coverage, either under the literal language of the claims or under the doctrine of equivalents, may have been given up by claim amendment or argument. Access to office actions, amendments and responses, and other prosecution at least through the issue date of the '003 patent is respectfully requested.

Petitioner is aware that the applicant has requested that above referenced application be placed in interference with another patent. Petitioner is not requesting access to any affidavits or declarations under 37 C.F.R. §1.608(b). Petitioner is merely requesting access to those prosecution documents bearing on the issue of patentability to applicant of any battery tester label or process for preparing a battery tester label.

Accordingly, petitioner believes that the benefit to the public of having a full understanding of the scope of the claims of the '003 patent clearly outweighs any secrecy interest applicant may have in connection with the subject pending patent application. The basic application as embodied in the '003 patent and the corresponding European patent application are already public knowledge. Certainly, if the applicant wished to have prosecution of the subject application remain secret, it

would not have claimed benefit of the filing date of the application in the '003 patent. Without such access, petitioner and other members of the public would not be able to make a proper determination of the scope and coverage of the claims of the '003 patent.

This petition is being filed in duplicate along with a check for \$130 for the petition fee under §1.17(i)(1). Please charge any underpayment of fees, or credit any overpayment, to deposit account no. 04-0566.

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date indicated below as First Class mail in an envelope addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231.

Name: Peter W. Peterson Date: 9/24/93 Signature: 